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IN THE

Supreme Court of the United States

OCTOBER TERM, 1954

No. 211

EDWARD B. MARKS MUSIC CORPORATION,

Petitioner,

against

CONTINENTAL RECORD COMPANY, INC. and REMINGTON RECORDS, INC.,

Respondents.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

FULTON BRYLAWSKI,
Attorney for Petitioner.

FULTON BRYLAWSKI,
JULIAN T. ABELES,
Of Counsel.

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PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

TO THE HONORABLE, THE CHIEF JUSTICE AND THE ASSOCIATE JUSTICES OF THE SUPREME COURT OF THE UNITED STATES:

Petitioner prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Second Circuit in the within action, dated and entered April 13, 1955, affirming the final judgment of the United States District Court for the Southern District of New York, entered on March 22, 1954 upon the defendants' motion for summary judgment, dismissing the complaint upon the merits.

Opinions Below

The opinion of the District Court (R. 27, 28) is reported at 120 F. Supp. 275. The opinion of the Court of Appeals, affirming the judgment of the District Court (Appendix 1, *infra*) is unreported. The opinion of the Court of Appeals denying the motion of defendants below for an allowance of counsel fees on appeal (Appendix 1, *infra*) is unreported.

Jurisdiction

The judgment of the Court of Appeals (Appendix II, *infra*) is dated and was entered on April 13, 1955. Jurisdiction is conferred on this Court by 28 U. S. C. Section 1254(1).

Questions Presented

1. Does the proviso of Section 1(e) of the Copyright Act of 1909 (17 U. S. C. 35 Stat. 1075, *et seq.*, hereinafter referred to as the "Copyright Act") exclude musical compositions published and copyrighted after July 1, 1909, from the benefits of mechanical reproduction under the Act, by reason of their having been *first* published and copyrighted prior to said date?

2. Is a renewal copyright, obtained subsequent to July 1, 1909, a distinct statutory grant under the existing Act, or merely an extension of the original grant under the prior Act?

3. Does the mechanical reproduction of a musical composition first published and copyrighted prior to July 1, 1909, and republished and in respect to which the copyright is renewed under Section 24 of the Copyright Act after said date, in the absence of both a license agreement

and of service of notice under Section 101(e) of the Act of the intention to make such use, constitute an infringement of the renewal copyright under the purview of Section 101(e) of the Act?

Statutes and Rules Involved

(Appendix III, *infra*)

Statement

The action is for the infringement of the renewal copyright in plaintiffs' musical composition entitled "In The Good Old Summer Time", by the unauthorized mechanical reproduction by defendants of said composition on phonograph records (R. 2-7).

Plaintiff's composition was first published and copyrighted in 1902 (R. 3). The renewal copyright was obtained in 1929 (R. 15, 19, 25, 26) and was duly assigned to plaintiff in 1932 through mesne instruments of assignment (R. 15, 16, 19, 20, 24-26).

The composition was republished by plaintiff during the renewal term, in a new edition in 1932, and in a second new edition in 1949 "With Six Special New 1949 Choruses" in conjunction with the release for exhibition at that time of "M-G-M's Musical" motion picture production of the same title (R. 16, 20, 21).

On December 29, 1935, during the renewal term, plaintiff duly filed notice under Section 1(e) of the Copyright Act of having licensed the use of the composition during the renewal term for mechanical reproduction on phonograph records (R. 5).

The defendants, in their answer, admit "that they have manufactured and sold phonograph records embodying the musical composition 'In The Good Old Summer Time'" (R. 8).

Both plaintiff and defendants moved for summary judgment under Rule 56, Federal Rules of Civil Procedure, and defendants likewise moved for judgment on the pleadings under Rule 12, Federal Rules of Civil Procedure. The District Court denied plaintiffs' motion for summary judgment and defendants' motion for judgment on the pleadings, but granted defendants' motion for summary judgment (R. 10, 11).

The District Court in its opinion (R. 27, 28), while recognizing that the composition was both republished and copyrighted after July 1, 1909, nevertheless held that "having been *first* copyrighted and published on May 24, 1902, the mechanical reproduction thereof was in the public domain from that time on" as the 1909 revision of the Copyright Act (proviso of Section 1(e)) "*specifically excluded compositions published and copyrighted prior to July 1, 1909.*" (Italics supplied.)

This determination of the District Court was upon the theory that as a renewal copyright is not a new grant, but merely an extension of only such rights as were granted for the original term, the renewal copyright cannot "be held to have created an author's control of mechanical reproduction previously non-existent."

To sustain its determination the District Court would in effect revise the text of the proviso of Section 1(e), to comprehend only compositions *first* published and copyrighted after July 1, 1909, and to have compositions published and copyrighted both prior to and after said date "specifically excluded"; the quoted wording found in the District Court's opinion being entirely foreign to the text of the proviso.

The Court below affirmed the judgment of the District Court upon the same theory, that the language of Section 24 of the Copyright Act, to the effect that the author and others designated shall be entitled to a "renewal and extension of the copyright", mitigates against plaintiff's con-

tention that a renewal copyright is a new statutory grant under the purview of the proviso of Section 1(e) of the Act.

The Court below recognizes that there are "many authorities for the proposition that a renewal copyright creates a right distinct from that obtained under the original copyright", but says that they were only "concerned with the ownership of renewal rights or with problems having no relation to the ones involved in these proceedings". The Court below does not explain the basis for its reasoning, that a renewal copyright *"creates a right distinct from that obtained under the original copyright"* in every instance except in relation to the question "involved in these proceedings." (Italics supplied)

The basis for federal jurisdiction of the District Court was c. 646, 62 Stat. 931, 28 U. S. C. Section 1338 (a).

Reasons for Granting the Writ

A

The Court Below Recognized That There Was No "Precedent" For Its Determination, Which "Involved A Novel Question Of Statutory Interpretation". This Novel Question, Affecting Large Property Interests, Has Not Been But Should Be Settled By This Court.

Because of the importance of this unsettled question, involving large property interests Record Industry Association of America, Inc., Songwriters Protective Association and Music Publishers Protective Association, Inc. filed briefs *amici curiae*. The Court below in its opinion (Appendix 1, *infra*) said "None of the many briefs filed in this action have disclosed *a precedent which squarely controls the problem here presented*". Likewise, in its opinion denying the motion of the defendants below for an allowance of counsel fees on appeal (Appendix 1, *infra*) the

Court below said "Although in copyright cases such an allowance is within our discretionary power, 17 U. S. C. 116, we feel that in this case the unsuccessful litigant should not thus be penalized. The litigation which it instituted was not vexatious but *involved a novel question of statutory interpretation*". (Italics supplied)

This Court has allowed the writ in the following cases, involving a novel question of copyright statutory interpretation, where large property interests have been affected.

White-Smith Music Pub. Co. v. *Apollo Co.*, 209 U. S. 1, cited by the Court below in its opinion (Appendix 1, *infra*). The facts are peculiarly akin to those in the instant case. The action for copyright infringement, likewise brought by a music publisher against a recording company, posed the question whether the Copyright Act, prior to the inclusion of Section 1(e) by the 1909 amendment, protected the plaintiff from the unauthorized reproduction of its musical compositions on music rolls. This Court allowed the writ saying (pp. 9, 15):

> "It is evident that the question involved in the use of such rolls is one of very considerable importance, involving large property interests, and closely touching the rights of composers and music publishers. • • •
>
> In the last analysis this case turns upon the construction of a statute, for it is perfectly well settled that the protection given to copyrights in this country is wholly statutory."

Fred Fisher Music Co. v. *M. Witmark & Sons*, 318 U. S. 643, 647:

> "This case presents a question never settled before, even though it concerns legislation having a history of more than two hundred years. • • •

Because of the obvious importance of this question of the proper construction of the Copyright Act, we brought the case here."

Sheldon v. *Metro-Goldwyn Pictures Corp.*, 309 U. S. 390, 396, 397:

"In view of the importance of the question, which appears to be one of the first impression in the application of the copyright law, we granted certiorari."

To the same effect:

Herbert v. *The Shanley Company*, 242 U. S. 591;
L. A. Westermann Company v. *Dispatch Printing Company*, 249 U. S. 100;
Fox Film Corp. v. *Knowles*, 261 U. S. 326;
Washingtonian Publishing Co. v. *Pearson*, 306 U. S. 30.

B

A Proviso In A Statute Must Be Construed Strictly And Held To Apply Only To Cases Shown To Be Clearly Within Its Purpose. Those Who Set Up Any Such Exception Must Establish It As Being Within The Words As Well As Within The Reason Thereof.

United States v. *Dickson*, 40 U. S. 141, 165:

"; we are led to the general rule of law, which has always prevailed, and become consecrated almost as a maxim in the interpretation of statutes, that where the enacting clause is general in its language and objects, and a proviso is afterwards introduced, that proviso is construed strictly, and takes no case out of the enacting clause which does not fall fairly within its terms. In short, a proviso carves special exceptions

only out of the enacting clause; and those who set up any such exception, must establish it as being within the words as well as within the reasons thereof."

Ryan v. *Carter,* 93 U. S. 78, 83:

"The general rule of law is, that a proviso carves special exceptions only out of the body of the act; and those who set up any such exception must establish it, as being within the words as well as the reason thereof. *United States* v. *Dickson,* 15 Pet. 165."

United States v. *McElvain,* 272 U. S. 633, 639:

"It is to be construed strictly, and held to apply only to cases shown to be clearly within its purpose. *United States* v. *Dickson,* 15 Pet. 141, 165; *Ryan* v. *Carter,* 93 U. S. 78, 83."

(1) For The Proper Construction Of The Proviso Of Section 1(e) Of The Act Consideration Should Be Given To Its Purpose And Its Legislative History.

McDonald v. *United States,* 279 U. S. 12, 22:

"For the proper construction of the provision in question, consideration need not be limited to the subdivision in which it is found; the general purpose of the section may be taken into account. *United States* v. *Whitridge,* 197 U. S. 135, 143."

And as this Court said in *United States* v. *Morrow,* 266 U. S. 531, 535:

"This is emphasized when the proviso is examined in the light of prior legislation, the condition it was evidently intended to correct, and its legislative history. *Brushaber* v. *Union Pacific R. R. Co.,* 240 U. S. 1, 12; *Work* v. *Lynn, ante,* 161."

(2) Its Legislative History Shows That The "Real Purpose" Of The Proviso Of Section 1(e) Of The Act Was "To Leave Mechanical Reproducers Of Music Copyrighted Under Prior Statutes Free To Dispose Of Their Stock Of Records."

This was emphasized by the Court below in *Shilkret* v. *Musicraft Records, Inc.*, 131 F. 2d 929 (2d Cir.) cer. den., 319 U. S. 742 (pp. 931, 932):

> "We are convinced that it was not the purpose of the proviso to effect a discrimination between published and unpublished copyrighted musical compositions. To give it a meaning which necessitates that result makes it repugnant to the main body of section 1(e). *The real purpose of the proviso was to confine the right to compositions copyrighted after the effective date of the new Act and to leave mechanical reproducers of music copyrighted under prior statutes free to dispose of their stock of records.* This appears clearly from the discussion at the Committee Hearing between Chairman Currier and Mr. Burkan, who represented the Aeolian Company. See Shafter, Musical Copyright, 2d E., pp. 330, 331. *The language of the proviso suited that purpose in the case of published works but was inept for copyrights of unpublished works.*" (Italics supplied.)

In accord with the "real purpose" of the proviso the Court below in *Shilkret* v. *Musicraft Records, Inc., supra,* determined, that although the text seemed to limit the right to compositions both "published and copyrighted" after July 1, 1909, such purpose could have no possible application to unpublished compositions of which no mechanical reproductions had been made at the time of the effective date of the new Act, saying (p. 931):

> "Read literally the quoted phrase does seem to limit the right to compositions which are both published

> and copyrighted after July 1st. * * * No intelligible reason can be suggested why Congress should wish to forbid mechanical reproducers to infringe copyrighted works which had been published, but allow them to copy those which had not."

Applying the same reasoning, such purpose of the proviso could have no possible application to compositions republished and copyrighted over twenty years after July 1, 1909.

C

The Proviso Of Section 1(e) Of the Act Should Not Be Construed So Narrowly As To Make It Repugnant To The Very Purpose For Which The Main Body Of Section 1(e) Was Incorporated In The 1909 Revision Of The Act.

In *Werckmeister* v. *American Lithographic Co.*, 142 Fed. 827, aff'd by the Court below in open court 148 Fed. 1022 (2d Cir.), it was said (p. 831):

> "The object of the copyright law is beneficient. It was intended, in the language of the Constitution, 'to promote the progress of science and useful arts', and, in my opinion, the copyright laws should be liberally construed to carry out the intention of the Constitution."

The pertinent pronouncements of this Court are uniformly in accord.

As was said by this Court in *Washingtonian Publishing Co.* v. *Pearson, supra* (p. 36):

> "The Act of 1909 is a complete revision of the copyright laws, different from the earlier Act both in

scheme and language. It introduced many changes and was intended definitely to grant valuable, enforceable rights to authors, publishers, etc., without burdensome requirements; 'to afford greater encouragement to the production of literary works of lasting benefit to the world'."

In *Mittenthal* v. *Berlin*, 291 Fed. 714, cited with approval on the point by this Court in *Washingtonian Publishing Co.* v. *Pearson, supra*, the Court said (p. 715):

> "The purpose of the act of 1909 was to open a path for authors beside and not through the quagmire which had been created under the old act. I have no disposition to open another. Of course, the policy of the act must be enforced, but it does not lie in purposeless technicality."

In *Herbert* v. *The Shanley Company, supra*, a copyright infringement suit, this Court in reversing the determination of the Court below, which had likewise construed certain text of Section 1(e) adversely to the rights of the copyright proprietor of a musical composition, said (p. 594):

> "It is enough to say that there is no need to construe the statute so narrowly".

And as was said by this Court in *Fred Fisher Music Co.* v. *M. Witmark & Sons, supra* (p. 655):

> "A very small percentage of the copyrights are ever renewed. All use of them ceases in most cases long before the expiration of twenty-eight years. In the comparatively few cases where the work survives the original term the author ought to be given an adequate renewal term."

D

While Section 24 Of The Act Would Express To The Ordinary Reader The Intent To Secure The Continuance Of The Original Grant, In Realty An Entirely New Property Right And A New Power To Prevent Copying Under The Existing Statute Is Given To The Author Or Others Enumerated.

As this Court said in *Fox Film Corp.* v. *Knowles,* 261 U. S. 326, (pp. 327, 329):

> "Under these conditions it gives the executor the right to obtain the renewal for the benefit of the estate of the author, *as the new property right was in existence* at the time of the author's death. *White-Smith Music Pub. Co.* v. *Goff,* 187 Fed. 247; *Silverman* v. *Sunrise Pictures Corporation,* 273 Fed. 909.
>
> • • •
>
> The section read as a whole would *express to the ordinary reader* a general intent *to secure the continuance* of the copyright after the author's death and none the less so if the actual continuance was effected by creating a new estate, or if the beneficiaries in certain cases are pointed out." (Italics supplied)

In *White-Smith Music Pub. Co.* v. *Goff, supra,* cited with approval on the point by this Court in *Fox Film Corp.* v. *Knowles, supra,* the Court said (p. 250):

> "Here, then, was an entirely new policy, completely dissevering the title, *breaking up the continuance in a proper sense of the word,* whatever terms might be used, and vesting an absolutely new title eo nomine in the persons designated. • • •
>
> Whatever might occur afterwards would be *entirely a new grant,* and, *whatever further rights arose were disconnected from the original right.*" (Italics supplied)

In *Silverman* v. *Sunrise Pictures Corporation*, 273 Fed. 909, likewise cited with approval on the point by this Court in *Fox Film Corp.* v. *Knowles, supra*, the Court said (p. 911):

> "No one but the author, or his quasi assignee, the proprietor, can obtain the original copyright (Societe v. Vitagraph Co., 251 Fed. 258, 163 C. C. A. 414), while as was said in White, etc., Co. v. Goff, 187 Fed. 247, 109 C. C. A. 187, the statute *does not really give to the author a true extension or renewal, but authorizes 'a new grant to the author,* or the others enumerated' in section 24. See the same ruling as to an earlier act. Pierpont v. Fowle, 2 Woodb. & M. 23, Fed. Cas. No. 11, 152" (Italics supplied)

In *G. Ricordi & Co.* v. *Paramount Pictures, Inc.*, 189 F. 2d 469, 471 (2d Cir.), cer. den. 342 U. S. 849, the Court below said (citing and following *White-Smith Music Pub. Co.* v. *Goff, supra, Silverman* v. *Sunrise Pictures Corporation, supra* and *Fox Film Corp.* v. *Knowles*, 274 Fed. 731, 732, reversed on other grounds 261 U. S. 326):

> "A copyright renewal creates *a new estate*, and the few cases which have dealt with the subject assert that the new estate is clear of all rights, interests or licenses granted under the original copyright." (Italics supplied)

In *Fox Film Corp.* v. *Knowles, supra*, cited with approval on the point in *G. Ricordi & Co.* v. *Paramount Pictures, Inc., supra*, the Court said (p. 732):

> "When the renewal of the copyright is sought, a *new property right is created and a new power to prevent copyright given* to the persons entitled, not in any way dependent upon the previous bestowal of a similar authority." (Italics supplied)

The text book authorities are uniformly in accord.

Weil, *Copyright Law,* pages 366, 367:

"While the nomenclature used in connection with the second copyright term, refers to 'renewal' or 'extension,' what is, in reality, *conferred is a new copyright.* White-Smith Publishing Co. v. Goff, 187 F. 247. This is shown by the provisions differentiating between the proprietor of the original copyright and the persons, other than he, who are entitled to the so-called renewal." (Italics supplied.)

Ball, *Law of Copyright and Literary Property,* p. 193:

"The purpose of the statute is to give to the persons enumerated therein, and in the order named, *a new right independent of the property in the original copyright,* for the benefit of those naturally dependent upon the deceased author's bounty." (Italics supplied.)

Howell, *The Copyright Law,* 3rd Ed., p. 109:

"While the Copyright Act of 1909 uses the words 'renewal and extension', *it is not really a continuing right but is a new grant of copyright for a second term of* 28 years upon the filing of an appropriate application in the Copyright Office within one year prior to the expiration of the original term. This right, therefore, does not follow the ordinary rules of law in the case of testacy or intestacy and pass to the author's estate if he dies before the renewal year arrives." (Italics supplied.)

Ladas, *The International Protection of Literary and Artistic Property,* Vol. II, p. 771:

"*Renewal is not an accurate term* under the provisions of section 23. This is *not a continuation of the old copyright, but a new one,* since every proprietor of

a statutory copyright is not entitled to a renewal of such copyright on the expiration of the first twenty-eight years." (Italics supplied.)

Shafter, *Musical Copyright*, 2d Ed., p. 171:

"The renewal right itself is not to be considered a continuation of the original grant of copyright, *but an entirely new privilege.*" (Italics supplied.)

Amdur, *Copyright Law and Practice* (p. 555):

"The *scope of, and rights* under, a copyright depend upon the Act under which the copyright was secured. In the case of a renewal, *the rights and scope* are determined, not by the law existing at the time of securing the original copyright, *but by the law when the renewal was obtained,* inasmuch as the renewal is in effect a new grant." (Italics supplied.)

It will be noted that in the cited authorities (including those of this Court) specific mention is made that the "new grant" and the "new property right," under a renewal copyright, are given to the "author" as well as to the others designated. If, as the Court below says, such cases are concerned with "the ownership of renewal rights", then obviously such ownership by the author or others would extend to such "new grant" and "new property right", under the existing statute.

E

Any Intention To Confine The Application Of The Proviso Of Section 1(e) To Compositions "First" Published And Copyrighted After July 1, 1909 Would Have Been Specifically Expressed As In All Other Sections Of The Act.

The Court below in its opinion (Appendix 1, *infra*) says it seems clear that the construction by the District Court of the word "published" in the proviso of Section

1(e) of the Act, as meaning "first published" is correct. The Court below would find support for its determination, that Congress indicated there was a difference between such expressions, by reference to the wording of Section 8 of the Act that the "publication or republication" by the Government of copyrighted material shall not affect the copyright therein.

On the contrary, in the preceding Section 7, the words "republished" and "published" are used interchangeably, as meaning "published" under the Act. Thus, it is said that "works *republished* with new matter, *shall be regarded as new works* subject to copyright under the provisions of this title; but the *publication of any such new works* shall not affect the force or validity of any subsisting copyrights upon the matter employed or any part thereof." (Italics supplied.)

In this connection it is material to note, that in Section 24 of the Act it is specifically provided that the original copyright shall endure for twenty-eight years from the date of *"first publication"* and that in default of renewal the copyright shall determine at the expiration of twenty-eight years from *"first publication"*.

In the other sections of the Act, any intention to confine the application of the text to a "first publication" has likewise been specifically expressed.

Thus, Section 9 of the Act, headed "AUTHORS OR PROPRIETORS, ENTITLED; ALIENS", specifically provides "that the copyright secured by this title shall extend to the work of an author or proprietor who is a citizen or subject of a foreign state or nation only: (a) When an alien author or proprietor shall be domiciled within the United States at the time of the *first publication* of his work". (Italics supplied.)

Likewise, the *proviso* of Section 16 of the Act, headed "MECHANICAL WORK TO BE DONE IN THE UNITED STATES",

specifically provides that the requirements shall not apply to specified works imported into the United States within five years after *"first publication"*. (Italics supplied.)

The Court below refers to the definition of "the date of publication" in Section 26 (former Section 62) of the Act as the earliest date when copies of the first authorized edition were placed on sale, et cetera. The Court then goes on to say that a subsequent republication could not satisfy this statutory definition of "the date of publication".

There is no reference in Section 1(e) to "the date of publication" as defined in Section 26 of the Act. Furthermore, as has been pointed out, Section 24 of the Act specifically refers to the date of "first" publication.

In *Patterson* v. *Century Productions, Inc.*, 93 F. 2d 489, regarding the "date of publication" as defined in Section 26, the Court said (p. 492):

> "This, however, as Judge Augustus N. Hand said in Cardinal Film Corp. v. Beck et al, supra, 'was an enactment to fix the date from which the copyright term should begin to run, and not a general definition of what constituted publication.'"

In respect to the elasticity of the word "publication" as used in the Act:

> *Shilkret* v. *Musicraft Records, Inc., supra* (p. 932):
>
> "This is not the only instance of a word used loosely in the Act".
>
> *Marx* v. *United States*, 96 F. 2d 204, 206:
>
> "The word 'publication' has no definite and fixed meaning".

Conclusion

Since phonograph records are the essential source of revenue, without mechanical reproduction rights the renewal term of some of the most famous and lasting songs ever written (in the category of plaintiff's song "In The Good Old Summer Time") will be practically valueless. In adopting its narrow and strained construction of both Section 1(e) and Section 24 of the Copyright Act, the Court below has completely frustrated the beneficent object of the Act. Accordingly, the granting of a writ of certiorari by this Court is essential to protect the large and valuable property interests which are affected by such adverse determination below.

Dated, New York, June 30, 1955.

Respectfully submitted,

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Attorney for Petitioner.

FULTON BRYLAWSKI,
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APPENDIX I

Opinion of the Court Below Upon Affirmance.

UNITED STATES COURT OF APPEALS

FOR THE SECOND CIRCUIT

No. 157. October Term, 1954.

Argued February 10, 1955 Decided April 13, 1955

DOCKET NO. 23343

EDWARD B. MARKS MUSIC CORPORATION,

Plaintiff-Appellant,

against

CONTINENTAL RECORD COMPANY, INC., and REMINGTON RECORDS, INC.,

Defendants-Appellees.

Before: CLARK, Chief Judge, HINCKS, Circuit Judge and SMITH, District Judge.

Appeal from an order of the United States District Court for the Southern District of New York granting defendants' motion for summary judgment and dismissing the complaint. Sidney Sugarman, Judge. Affirmed.

Abeles & Bernstein, for *appellant.*

Maxwell Okun, for *appellees.*

Rosenman, Goldmark, Colin & Kaye, (Godfrey Goldmark, Ambrose Doskow, of counsel) for Record Industry Association of America, Inc., *Amicus Curiae.*

Appendix I

William Klein, II and John Schulman, for Songwriters Protective Association, and Sidney Wm. Wattenberg, for Music Publishers Association, Inc., *Amicus Curias.*

HINCKS, Circuit Judge:

The plaintiff-appellant is the assignee of the renewal copyright in the musical composition entitled, "In The Good Old Summertime." This composition was first published and copyrighted in 1902. A renewal copyright was obtained on the lyric in 1929, and on the music in 1930. During the renewal term the plaintiff, alleging that he has published two new editions of the composition, instituted an action charging the defendants with infringement of the renewal copyright by the sale of phonograuh records of a "version" of the composition, without obtaining plaintiff's consent. The defendants admit that they have manufactured and sold phonograph records "embodying" plaintiff's composition but they deny the allegation of infringement. In the court below the plaintiff moved for summary judgment and the defendants sought judgment on the pleadings. Both motions were denied. The defendants also moved for summary judgment. That motion was granted and the complaint dismissed. It is from this judgment of dismissal that the present appeal is taken.

On appeal the principal question argued was whether Section 1(e) of the Copyright Act of 1909, 17 U. S. C. 1(e), 35 Stat. 1075, protects the plaintiff from unauthorized mechanical reproduction of its composition on phonograph records.

Prior to 1909, mechanical reproduction of compositions even if copyrighted was in the public domain and hence unauthorized mechanical reproduction on phonograph records was permissible. See *White Smith Music Publishing Company* v. *Apollo Co.*, 209 U. S. 1, *Shilkret* v. *Music-*

craft Records, 2 Cir., 131 F, 2d 929. In 1909 Congress so amended the copyright law, 17 U. S. C. A. 1, as to extent to the holder of a copyright protection against unauthorized mechanical reproductions which, under the rule of the cases just cited, had theretofore been lacking. But this extended protection was limited by Section 1(e) of the 1909 Act, 17 U. S. C. A. 1(e), which so far as here pertinent we set out in the margin.[1] The words with which we are most concerned are those which specify that the protection afforded against the mechanical reproduction of compositions "shall include only compositions published and copyrighted after July 1, 1909." It is undisputed that the composition here involved was first published and copyrighted before 1909, and it is abundantly clear that, under the *White Smith* and *Shilkret* cases, the composition, prior to July 1, 1909, was not protected against mechanical reproductions. Nevertheless, the plaintiff contends that by virtue of its renewal copyrights in 1929-1930 it is now entitled under the Amendatory Act of 1909 to protection against mechanical reproductions. Plaintiff argues that the renewal of the copyright created a new estate, *i. e.*, a new grant of copyright separate and independent from the first copyright and that, since the

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[1] The pertinent portion of Section 1(e) of the 1909 Act, 17 U. S. C. 1(e), reads as follows:

> "To perform the copyrighted work publicly for profit if it be a musical composition; and for the purpose of public performance for profit, and for the purposes set forth in subsection (a) hereof, to make an arrangement or setting of it or of the melody of it in any system of notation or any form of record in which the thought of an author may be recorded and from which it may be read or reproduced: Provided, That the provisions of this title, so far as they secure copyright controlling the parts of instruments serving to reproduce mechanicaly the musical work, shall include only compositions published and copyrighted after July 1, 1909, and * * *."

renewal was obtained after 1909, the composition is protected under Section 1(e).

The plaintiff cites many authorities for the proposition that a renewal copyright creates a right distinct from that obtained under the original copyright. But it has lifted this concept from cases concerned with the ownership of renewal rights or with problems having no relation to the ones involved in these proceedings. Such cases are not determinative of the question here posed. None of the many briefs filed in this action have disclosed a precedent which squarely controls the problem here presented.

We think the words above quoted from the *proviso* to Section 1(e) are clearly destructive of the plaintiff's contention that Congress intended that the mechanical reproduction of a song, which for years had been in the "public domain," may by renewal, be fenced into a monopolistic field. Nor do we find anything in Section 24 of the Copyright Act, 35 Stat. 1081, 17 U. S. C. A. 24, providing for the renewal of copyrights, which lends support to the plaintiffs' position. The phrasing utilized in Section 24, particularly when read in conjunction with Section 1(e) suggests a contrary conclusion. For Section 24 does not state that a renewal operates as the grant of a new monopoly having a larger field than the original copyright. It states simply that "subsisting" copyright may "be renewed and extended" and that in certain instances such renewal and extension may be had "for a further period such that the entire term shall be equal to that secured by this Act, including the renewal period." Section 24 requires that application for renewal or extension is to be made "one year prior to the expiration of the existing term." Such language militates against the interpretation of Section 1(e) for which the plaintiff contends.

Plaintiff links with his argument the proposition that when it printed two new editions of the song during the

renewal period it "republished" the composition and that such *republishing* comes within the meaning of the term "published" appearing in the proviso to Section 1(e). The force of this argument we think impaired by our treatment of plaintiff's renewal theory. But that aside, it seems clear that the construction by the court below of the word "published" as meaning "first published" is correct. The legislative history of Section 1(e) does not indicate that anything to the contrary was intended. See H. R. 2222, 60th Congress, 2nd Sess.

A reading of the Act in its entirety reinforces the conclusion just expressed. The proviso to Section 7 of the Act of 1909, 35 Stat. 1077, now 17 U. S. C. A. 8, uses the words "publication or republication" which fairly indicates that Congress thought there was a difference between such expressions and, if its intent had been to provide the rights here sought by appellant, it would have used the words "published or republished" in the proviso to Section 1(e). It is also to be noted that Section 62 of the Act of 1909, 35 Stat. 1087, now 17 U. S. C. A. 26, states that "the date of publication shall in the case of a work of which copies are reproduced for sale or distribution be held to be the earliest date when copies of the first authorized edition were placed on sale, sold, or publicly distributed by the proprietor of the copyright or under his authority * * *." Plainly, a republication after copies of the first edition were placed on sale could not satisfy this statutory definition of "the date of publication."

All things considered, we hold that under the Amendatory Act of 1909 the plaintiff by a renewal did not acquire a right, theretofore lacking, to protection from mechanical reproduction on phonograph records.

But the plaintiff contends that the court below erred in disposing of the case on a motion for summary judgment: that the pleadings framed a genuine issue of fact on which

it was entitled to a trial. This contention is based on paragraph 15 of the plaintiff's complaint, in which it was alleged: "After December 29, 1937, defendants and each of them infringed said renewal copyright, in that without any authorization, permission, consent or license of plaintiff, defendants produced, and manufactured, placed upon the market and sold parts of instruments serving to reproduce mechanically, a *version of said musical work.*" (Emphasis supplied) By its answer, the defendant, among other defenses, denied that it had mechanically reproduced a *version* of the copyright composition. However, when the plaintiff moved for summary judgment it abandoned its contention that the defendant had reproduced a *version.* It rested its motion on two supporting affidavits wherein it was stated: "The action is brought to recover damages and for incidental relief, for defendants' infringement of the renewal copyright on its musical composition entitled 'In the Good Old Summertime' by the unauthorized manufacture and sale of parts of instruments serving to reproduce mechanically (on phonograph records) *said musical* work." (Emphasis supplied) Nothing in its papers on this motion indicated that the plaintiff claimed protection from the reproduction of adaptations or versions of the composition. The relief sought was limited to protection against the reproduction of the composition in its original form.

However, we do not rest on the papers addressed to the plaintiff's motion for summary judgment. More significant is the fact that when the defendants cross-moved for summary judgment without injecting into the case any issue relating to a *version* of the composition, the plaintiff's supplemental affidavit in opposition to the cross-motion not only failed to present any data tending to establish the existence of a genuine issue of fact but also wholly failed even to refer to any claim of an infringing

version. It is thus apparent that the plaintiff was content to submit on the question of law which we have decided adversely to its contention, and that the formal issue in the pleadings as to a version of the composition was merely a sham issue which should not be allowed to frustrate the beneficient objectives of Rule 56 of the Federal Rules of Civil Procedure. The Rule was designed to enable the trial judge, by piercing formal verbiage, to filter out of the pleadings sham issues which might otherwise cause needless and time-consuming litigation. *Engl* v. *Aetna Life Insurance Co.*, 2 Cir., 139 F. 2d 469; *Willingham* v. *Eastern Air Lines*, 2 Cir., 199 F. 2d 623; 6 Moore's Federal Practice, Par. 56.12 (2). Cf. Justice Cardozo's language in his opinion in *Richard* v. *Credit Suisse*, 242 N. Y. 346, 152 N E. 110. But a plaintiff in his opposition to a motion for summary judgment cannot abandon an issue and then, after an unpalatable decision by the trial judge, on appeal, by drawing on the pleadings resurrect the abandoned issue. This is especially so here because a reading of Paragraph 15 in the context of the entire complaint strongly suggests that its use of the word "version" was no more than fortuitous and never intended as the basis for a substantial claim.

The parties have also addressed argument to the question whether, as a matter of law, the plaintiff is entitled to protection against mechanical reproductions of *versions* of the composition here involved. The trial judge thought not. Since we are satisfied that he rightly granted the defendants' motion for summary judgment on the theory that the motion papers did not raise any genuine issue of fact involving that question, we express no view on that point.

Affirmed.

Appendix I

Opinion of the Court Below Upon the Denial of the Motion of Defendants Below for an Allowance of Counsel Fees on Appeal.

UNITED STATES COURT OF APPEALS

FOR THE SECOND CIRCUIT

No. 157. October Term, 1954.

Motion submitted April 26, 1955. Decided May 10, 1955.

Docket No. 23343.

EDWARD B. MARKS MUSIC CORPORATION,

Plaintiff-Appellant,

against

CONTINENTAL RECORD COMPANY, INC., and REMINGTON RECORDS, INC.,

Defendants-Appellees.

Before:

CLARK, Chief Judge, HINCKS, Circuit Judge and SMITH, District Judge.

MOTION FOR ALLOWANCE OF COUNSEL FEES ON APPEAL

per curiam:

The defendants below, who prevailed in the trial Court and again on appeal, seek an order allowing as part of the taxable costs the fees of their attorneys for services in

prosecuting the appeal. Although in copyright cases such an allowance is within our discretionary power, 17 U. S. C. 116, we feel that in this case the unsuccessful litigant should not thus be penalized. The litigation which it instituted was not vexatious but involved a novel question of statutory interpretation. We find no basis for questioning the good faith of the plaintiff in instigating the litigation. *Official Aviation Guide Co., Inc.* v. *American Aviation Associates,* 7 Cir., 162 F. 2d 541; *Overman* v. *Loesser,* 9 Cir., 205 F. 2d 521, cert. den. 346 U. S. 910.

Motion denied.

APPENDIX II

Judgment of Affirmance

UNITED STATES DISTRICT COURT

FOR THE SECOND CIRCUIT

At a Stated Term of the United States Court of Appeals, in and for the Second Circuit, held at the United States Courthouse in the City of New York, on the 13th day of April, one thousand nine hundred and fifty-five.

Present:

HON. CHARLES E. CLARK, Chief Judge,
HON. CARROLL C. HINCKS, Circuit Judge,
HON. J. JOSEPH SMITH, District Judge.

EDWARD B. MARKS MUSIC CORP.,
Plaintiff-Appellant,

against

CONTINENTAL RECORD & *Ano.*,
Defendants-Appellees.

Appeal from the United States District Court for the Southern District of New York.

This cause came on to be heard on the transcript of record from the United States District Court for the Southern District of New York, and was argued by counsel.

ON CONSIDERATION WHEREOF, it is now hereby ordered, adjudged, and decreed that the judgment of said District Court be and it hereby is affirmed.

It is further ordered that a Mandate issue to the said District Court in accordance with this decree.

/s/ A. DANIEL FUSARO,
Clerk.

APPENDIX III

Statutes and Rules Involved

Copyright Act of 1909 (17 U. S. C., 39 Stat. 1075, *et seq.*)

"Section 1. EXCLUSIVE RIGHTS AS TO COPYRIGHTED WORKS.—Any person entitled thereto, upon complying with the provisions of this title, shall have the exclusive right: * * *.

(e) To perform the copyrighted work publicly for profit if it be a musical composition; and for the purpose of public performance for profit, and for the purposes set forth in subsection (a) hereof, to make any arrangement or setting of it or of the melody of it in any system of notation or any form of record in which the thought of an author may be recorded and from which it may be read or reproduced: *Provided,* That the provisions of this title, so far as they secure copyright controlling the parts of instruments serving to reproduce mechanically the musical work, shall include only compositions published and copyrighted after July 1, 1909, and shall not include the works of a foreign author or composer unless the foreign state or nation of which such author or composer is a citizen or subject grants, either by treaty, convention, agreement, or law, to citizens of the United States similar rights. And as a condition of extending the copyright control to such mechanical reproductions, that whenever the owner of a musical copyright has used or permitted or knowingly acquiesced in the use of the copyrighted work upon the parts of instruments serving to reproduce mechanically the musical work, any other person may make similar use of the copyrighted work upon the payment to the copyright proprietor of a royalty of 2 cents on each such part manufactured, to be paid by the manufacturer thereof; and the copyright proprietor may require, and if so the manufacturer shall furnish, a report under oath on the 20th day of each month on the

number of parts of instruments manufactured during the previous month serving to reproduce mechanically said musical work, and royalties shall be due on the parts manufactured during any month upon the 20th of the next succeeding month. The payment of the royalty provided for by this section shall free the articles or devices for which such royalty has been paid from further contribution to the copyright except in case of public performance for profit. It shall be the duty of the copyright owner, if he uses the musical composition himself for the manufacture of parts of instruments serving to reproduce mechanically the musical work, or licenses others to do so, to file notice thereof, accompanied by a recording fee, in the copyright office, and any failure to file such notice shall be a complete defense to any suit, action, or proceeding for any infringment of such copyright.

Section 7. COPYRIGHT ON COMPILATIONS OF WORKS IN PUBLIC DOMAIN OR OF COPYRIGHTED WORKS; SUBSISTING COPYRIGHTS NOT AFFECTED.—Compilations or abridgments, adaptations, arrangements, dramatizations, translations, or other versions of works in the public domain or of copyrighted works when produced with the consent of the proprietor of the coypright in such works, or works republished with new matter, shall be regarded as new works subject to copyright under the provisions of this title; but the publication of any such new works shall not affect the force or validity of any subsisting copyright upon the matter employed or any part thereof, or be construed to imply an exclusive right to such use of the original works, or to secure or extend copyright in such original works.

Section 8. COPYRIGHT NOT TO SUBSIST IN WORKS IN PUBLIC DOMAIN, OR PUBLISHED PRIOR TO JULY 1, 1909, AND NOT ALREADY COPYRIGHTED, OR GOVERNMENT PUBLICATIONS; PUBLICATION BY GOVERNMENT OF COPYRIGHTED MATERIALS.—No

copyright shall subsist in the original text of any work which is in the public domain, or in any work which was published in this country or any foreign country prior to July 1, 1909, and has not been already copyrighted in the United States, or in any publication of the United States Government, or any reprint, in whole or in part, thereof; *Provided,* That copyright may be secured by the Postmaster General on behalf of the United States in the whole or any part of the publications authorized by section 1 of the Act of January 27, 1938 (39 U. S. C. 371).

The publication or republication by the Government, either separately or in a public document, or any material in which copyright is subsisting shall not be taken to cause any abridgment or annulment of the copyright or to authorize any use or appropriation of such copyright material without the consent of the copyright proprietor.

Section 9. AUTHORS OR PROPRIETORS, ENTITLED; ALIENS.—The author or proprietor of any work made the subject of copyright by this title, or his executors, administrators, or assigns, shall have copyright for such work under the conditions and for the terms specified in this title: *Provided, however,* That the copyright secured by this title shall extend to the work of an author or proprietor who is a citizen or subject of a foreign state or nation only:

(a) When an alien author or proprietor shall be domiciled within the United States at the time of the first publication of his work; * * *

Section 16. MECHANICAL WORK TO BE DONE IN UNITED STATES.—Of the printed book or periodical specified in section 5, subsections (a) and (b), of this title, except the original text of a book or periodical of foreign origin in a language or languages other than English, the text of all copies accorded protection under this title, except as below

provided, shall be printed from type set within the limits of the United States, either by hand or by the aid of any kind of typesetting machine, or from plates made within the limits of the United States from type set therein, or, if the text be produced by lithographic process, or photoengraving process, then by a process wholly performed within the limits of the United States, and the printing of the text and binding of the said book shall be performed within the limits of the United States; which requirements shall extend also to the illustrations within a book consisting of printed text and illustrations produced by lithographic process, or photoengraving process, and also to separate lithographs or photoengravings, except where in either case the subjects represented are located in a foreign country and illustrate a scientific work or reproduce a work of art: *Provided, however,* That said requirements shall not apply to work in raised characters for the use of the blind, or to books or periodicals of foreign origin in a language or languages other than English, or to works printed or produced in the United States by any other process than those above specified in this section, or to copies of books or periodicals, of foreign origin, in the English language, imported into the United States within five years after first publication in a foreign state or nation up to the number of fifteen hundred copies of each such book or periodical if said copies shall contain notice of copyright in accordance with sections 10, 19, and 20 of this title and if ad interim copyright in said work shall have been obtained pursuant to section 22 of this title prior to the importation into the United States of any copy except those permitted by the provisions of section 107 of this title: *Provided further,* That the provisions of this section shall not affect the right of importation under the provisions of section 107 of this title, nor the extension of time within which to comply with conditions and formalities granted by Presidential proclamation, No. 2608, of March 14, 1944.

Appendix III

Section 24. DURATION; RENEWAL AND EXTENSION.—The copyright secured by this title shall endure for twenty-eight years from the date of first publication, whether the copyrighted work bears the author's true name or is published anonymously or under an assumed name: *Provided,* That in the case of any posthumous work or of any periodical, cyclopedic, or other composite work upon which the copyright was originally secured by the proprietor thereof, or of any work copyrighted by a corporate body (otherwise than as assignee or licensee of the individual author) or by an employer for whom such work is made for hire, the proprietor of such copyright shall be entitled to a renewal and extension of the copyright in such work for the further term of twenty-eight years when application for such renewal and extension shall have been made to the copyright office and duly registered therein within one year prior to the expiration of the original term of copyright: *And provided further,* That in the case of any other copyrighted work, including a contribution by an individual author to a periodical or to a cyclopedic or other composite work, the author of such work, if still living, or the widow, widower, or children of the author, if the author be not living, or if such author, widow, widower, or children, be not living, then the author's executors, or in the absence of a will, his next of kin shall be entitled to a renewal and extension of the copyright in such work for a further term of twenty-eight years when application for such renewal and extension shall have been made to the copyright office and duly registered therein within one year prior to the expiration of the original term of copyright: *And provided further,* That in default of the registration of such application for renewal and extension, the copyright in any work shall determine at the expiration of twenty-eight years from first publication.

Appendix III

Section 26. TERMS DEFINED.—In the interpretation and construction of this title "the date of publication" shall in the case of a work of which copies are reproduced for sale or distribution be held to be the earliest date when copies of the first authorized edition were placed on sale, sold, or publicly distributed by the proprietor of the copyright or under his authority, and the word "author" shall include an employer in the case of works made for hire.

Section 101. INFRINGEMENT.—

* * *

(e) ROYALTIES FOR USE OF MECHANICAL REPRODUCTION OF MUSICAL WORKS.—Whenever the owner of a musical copyright has used or permitted the use of the copyrighted work upon the parts of musical instruments serving to reproduce mechanically the musical work, then in case of infringement of such copyright by the unauthorized manufacture, use, or sale of interchangeable parts, such as disks, rolls, bands, or cylinders for use in mechanical music-producing machines adapted to reproduce the copyrighted music, no criminal action shall be brought, but in a civil action an injunction may be granted upon such terms as the court may impose, and the plaintiff shall be entitled to recover in lieu of profits and damages a royalty as provided in section 1, subsection (e), of this title: *Provided also,* That whenever any person, in the absence of a license agreement, intends to use a copyrighted musical composition upon the parts of instruments serving to reproduce mechanically the musical work, relying upon the compulsory license provision of this title, he shall serve notice of such intention, by registered mail, upon the copyright proprietor at his last address disclosed by the records of the copyright office, sending to the copyright office a duplicate of such notice; and in case of his failure so to

do the court may, in its discretion, in addition to sums hereinabove mentioned, award the complainant a further sum, not to exceed three times the amount provided by section 1, subsection (e), of this title, by way of damages, and not as a penalty, and also a temporary injunction until the full award is paid.

28 U. S. C. Section 1254. COURT OF APPEALS: CERTIORARI; etcetera.

Cases in the courts of appeals may be reviewed by the Supreme Court by the following method:

(1) By writ of certiorari granted upon the petition of any party to any civil or criminal case, before or after the rendition of judgment or decree;

28 U. S. C. Section 1338. PATENTS, COPYRIGHTS, TRADE MARKS AND UNFAIR COMPETITION.

(a) The district courts shall have original jurisdiction of any civil action arising under any Act of Congress relating to patents, copyrights and trade-marks. Such jurisdiction shall be exclusive of the courts of the states in patent and copyright cases.

FEDERAL RULES OF CIVIL PROCEDURE
Rule 56 SUMMARY JUDGMENT

(a) FOR CLAIMANT. A party seeking to recover upon a claim, counterclaim, or cross-claim or to obtain a declaratory judgment may, at any time after the expiration of 20 days from the commencement of the action or after service of a motion for summary judgment by the adverse party, move with or without supporting affidavits for a summary judgment in his favor upon all or any part thereof.

(b) FOR DEFENDING PARTY. A party against whom a claim, counterclaim, or cross-claim is asserted or a declaratory judgment is sought may, at any time, move with or without supporting affidavits for a summary judgment in his favor as to all or any part thereof.

(c) MOTION AND PROCEEDINGS THEREON. The motion shall be served at least 10 days before the time fixed for the hearing. The adverse party prior to the day of hearing may serve opposing affidavits. The judgment sought shall be rendered forthwith if the pleadings, depositions, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law. A summary judgment, interlocutory in character, may be rendered on the issue of liability alone although there is a genuine issue as to the amount of damages."

FILED
SEP 12 1955
HAROLD B. WILLEY, Clerk

IN THE

Supreme Court of the United States

OCTOBER TERM, 1955.

No. 211.

EDWARD B. MARKS MUSIC CORPORATION,

Petitioner,

against

CONTINENTAL RECORD COMPANY, INC. and REMINGTON RECORDS, INC.,

Respondents.

BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI.

MAXWELL OKUN,
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BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI.

Opinion Below.

The opinion of the Court of Appeals affirming the judgment of the District Court is reported at 227 F. (2d) 488.

Statutes Involved.

Section 1(e) of the Copyright Act of 1909 (35 Stat. 1075), as re-enacted without substantial change in the codification of 1947 (17 U. S. C., Sec. 1), is set forth in Appendix III to the petition (pp. 29-30). The pertinent portion thereof reads*:

> "EXCLUSIVE RIGHTS AS TO COPYRIGHTED WORKS.—Any person entitled thereto, upon complying with the provisions of this title, shall have the exclusive right:
>
> * * * * * *

* Emphasis added throughout.

"(e) To perform the copyrighted work publicly for profit if it be a musical composition; and for the purpose of public performance for profit, and for the purposes set forth in subsection (a) hereof, to make any arrangement or setting of it or of the melody of it in any system of notation or any form of record in which the thought of an author may be recorded and from which it may be read or reproduced: *Provided, That the provisions of this title, so far as they secure copyright controlling the parts of instruments serving to reproduce mechanically the musical work, shall include only compositions published and copyrighted after July 1, 1909,* * * * And as a condition of extending the copyright control to such mechanical reproductions, that whenever the owner of a musical copyright has used or permitted or knowingly acquiesced in the use of the copyrighted work upon the parts of instruments serving to reproduce mechanically the musical work, any other person may make similar use of the copyrighted work upon the payment to the copyright proprietor of a royalty of 2 cents on each such part manufactured, to be paid by the manufacturer thereof; * * * "

The Section under which the copyright in suit was renewed is not Section 24 of the present Act, set forth in the petition (Appendix III, p. 33), but Section 24 of the Act of 1909, relating to renewal and extension of copyrights subsisting when that Act took effect.* That Section read:

"SEC. 24. That the copyright subsisting in any work at the time when this Act goes into effect may, at the expiration of the term provided for under

* This Section was omitted from the codification of the statute enacted in 1947 (U. S. C. Title 17, 61 Stat. 652). It applied only to copyrights subsisting in 1909, which had been originally granted for a term of twenty-eight years. Accordingly, it had no application to any copyrights subsisting at the time of the codification.

existing law, *be renewed and extended* by the author of such work if still living, or the widow, widower, or children of the author, if the author be not living, or if such author, widow, widower, or children be not living, then by the author's executors, or in the absence of a will, his next of kin, *for a further period such that the entire term shall be equal to that secured by this Act, including the renewal period:* Provided, however, That if the work be a composite work upon which copyright was originally secured by the proprietor thereof, then such proprietor shall be entitled to the privilege of renewal and extension granted under this section: Provided, That application for such renewal and extension shall be made to the copyright office and duly registered therein within one year *prior to the expiration of the existing term.*"

Question Presented.

The case presents a single issue, which is not accurately stated in the three questions set forth in the petition (p. 2). The first question erroneously refers to the musical composition involved as "published and copyrighted after July 1, 1909". It was published and copyrighted prior to July 1, 1909, and thereafter the copyright was renewed and extended and the work reprinted. The second question stated, whether a renewal copyright is a distinct statutory grant or an extension of the original grant, is not in issue here; this case turns on the construction of Section 1(e) of the Copyright Act of 1909, which limited control of mechanical reproduction to compositions published and copyrighted after July 1, 1909. The third question is closer to a statement of the sole issue in this case, which we believe may be more accurately stated as follows:

> Does the right to control mechanical reproduction of copyrighted musical works, granted by Section

1(e) of the Copyright Act of 1909 with respect "only" to "compositions published and copyrighted after July 1, 1909", extend to compositions copyrighted and published prior to that date if the copyright therein was thereafter renewed and extended in accordance with Section 24 of that Act and copies thereof were thereafter reprinted and sold?

Statement.

The complaint charges infringement of the renewal copyright in a musical composition entitled IN THE GOOD OLD SUMMERTIME by the defendants' unauthorized manufacture and sale of "parts of instruments serving to reproduce mechanically" the work (R. 2-5). It alleges that the composition was published and copyrighted in 1902 (R. 3); that the copyright was renewed in 1929 and 1930 by the widows of the authors (R. 4), who thereafter assigned their rights to plaintiff (R. 4); and that after May, 1930, plaintiff "republished" the composition and sold copies of it (R. 4). An affidavit on behalf of petitioner shows that such "republication" consisted of the printing of new editions in 1932 and 1949 (R. 16).

The District Court granted defendants' motion for summary judgment. Its determination was not based, as petitioner states (p. 4), upon any theory as to whether renewal of copyright is a new grant. It was based upon the ground that the Act of 1909, which introduced protection of the right of mechanical reproduction, "specifically excluded compositions published and copyrighted prior to July 1, 1909"; and that renewal of the copyright "cannot, in the absence of any expression of Congressional intent so to do, be held to have created an author's control of mechanical reproduction, previously non-existent" (R. 27).

The Court of Appeals affirmed on the same ground. The petition (p. 5) misleadingly quotes excerpts from its opinion, taken out of context. The Court did not recognize that renewal creates a "right distinct" from that under the original copyright,—an issue that is not in the case. In the passage from which the quotations are taken, it pointed out the irrelevance of the authorities on which petitioner relied, as follows (petition, p. 22):

> "The plaintiff cites many authorities for the proposition that a renewal copyright creates a right distinct from that obtained under the original copyright. But it has lifted this concept from cases concerned with the ownership of renewal rights or with problems having no relation to the ones involved in these proceedings. Such cases are not determinative of the question here posed."

Despite petitioner's statement that the Court did not explain the basis of its reasoning, that explanation appears in the very next paragraph of the opinion, where the Court said:

> "We think the words above quoted from the *proviso* to Section 1(e) are clearly destructive of the plaintiff's contention that Congress intended that the mechanical reproduction of a song, which for years had been in the 'public domain,' may by renewal, be fenced into a monopolistic field. Nor do we find anything in Section 24 of the Copyright Act, 35 Stat. 1081, 17 U. S. C. A. 24, providing for the renewal of copyrights, which lends support to the plaintiffs' position. The phrasing utilized in Section 24, particularly when read in conjunction with Section 1(e) suggests a contrary conclusion."

ARGUMENT.

A.

The question presented relates to a limited and constantly decreasing number of copyrighted musical compositions, and is not of such importance as to warrant review by this Court.

The decision in this case can relate only to compositions copyrighted prior to July 1, 1909 which have not yet fallen into the public domain. The number of such compositions is, of course, constantly declining. The issue will become entirely academic after July 1, 1965 as the total copyright term, including the renewal term, is fifty-six years. 17 U. S. C. §24.

The very fact that the precise issue has not been decided during the period of forty-five years since the statute was passed is persuasive evidence that the issue does not have such importance as to justify consideration by this Court. It will be shown below that during that forty-five year period bills were introduced in the Congress to amend Section 1(e) to extend its protection to works copyrighted prior to 1909, and that express statements were made by interested parties at hearings on those bills that under the 1909 Act such works could be recorded without payment of royalties. If there were any substantial basis for the claim that royalties must be paid under renewed copyrights, such a claim would certainly have been asserted and litigated during the years when the affected compositions were much more numerous than they are now. The fact that the present question was not litigated during all those years shows that it is not now an issue that need be decided by this Court.

It will be shown, moreover, that petitioner's claim is wholly unsubstantial and that the decision below is clearly right. That decision gives effect to unambiguous statutory language. That it carries out the Congressional purpose is shown by the legislative history of the statute and by the history of attempts to amend it. Petitioner's effort to distort the statute and defeat its purpose creates no issue worthy of review by this Court.

B.

No substantial question is presented. Petitioner's claim leads to an absurd result and requires the distortion of unambiguous statutory language.

The composition here involved was published and copyrighted in 1902. At that time the right to reproduce it mechanically was in the public domain. Prior to the Copyright Act of 1909, the rights of a copyright proprietor did not include the right to exclude others from reproducing the work mechanically. *White-Smith Music Publishing Co.* v. *Apollo Company*, 209 U. S. 1. When the 1909 Act granted that right for the first time, it did so only as to compositions "published and copyrighted after" July 1, 1909. Accordingly, petitioner concedes that during the entire original term of the copyright—until 1930—the right of mechanical reproduction remained in the public domain. That concession is required by the cases. *Shilkret* v. *Musicraft Records*, 131 F. (2d) 929, 931 (C. C. A. 2d), cert. den. 319 U. S. 742; *M. Witmark & Sons* v. *Standard Music Roll Co.*, 221 Fed. 376, 378 (C. C. A. 3rd).

Petitioner claims, however, that when the original term was extended by the widows of the authors, and copies of the work were later reprinted by the widows' assignee, the

right of mechanical reproduction was removed from the public domain and brought under the control of the copyright proprietor for the remainder of the extended term. Such an application of the statute would be absurd and incongruous. It would mean that a work the copyright in which was extended immediately after July 1, 1909 would, if then reprinted, have become entitled to mechanical protection. The plain purpose to avoid retroactivity would thus immediately have been defeated.

There is no ambiguity either in Section 1(e), limiting mechanical protection to "include only compositions published and copyrighted after" July 1, 1909, or in Section 24, providing that a copyright subsisting when the Act took effect could "be renewed and extended . . . for a further period such that the entire term would be equal to that secured by this Act, including the renewal period." The requirement of Section 1(e) that the composition must have been both "published" and "copyrighted" prior to the effective date plainly expresses the intention to avoid the extension of mechanical protection retroactively to previously published compositions. The reference to the "entire term . . . including the renewal period" is the clearest possible indication that the scope and incidents of the copyright were not to be changed by renewal.

The composition here involved was neither "published" nor "copyrighted" after July 1, 1909 within the meaning of Section 1(e). The complaint alleges (R. 3) that it was both copyrighted and published in 1902.

The claim that the work was copyrighted after the 1909 Act took effect rests upon the fact that the copyright was "renewed and extended" after that date. It requires a complete distortion of the statutory language to regard that renewal and extension as the source of a newly created

recording right in the work. This is conceded by petitioner when it states (p. 12) that "Section 24 of the Act would express to the ordinary reader the intent to secure the continuance of the original grant".

Similarly, petitioner seeks to give the word "published" a wholly strained meaning in claiming that it includes the "republishing", i. e., the printing of new editions of the same work, after the copyright was renewed and extended. The word "published" in its most common usage refers to the initial distribution of copies by which common law copyright is lost. See *Holmes* v. *Hurst*, 174 U. S. 82, 88; *American Tobacco Company* v. *Werckmeister*, 207 U. S. 284, 299; *Patterson* v. *Century Productions*, 93 F. (2d) 489, 492 (C. C. A. 2nd). While petitioner claims that the word is loosely used in the statute and has no fixed meaning, the very cases it cites are cases in which the word was construed to refer to a single ascertainable event, and that construction was adopted in order to defeat a claim that was clearly contrary to the Congressional purpose. *Shilkret* v. *Musicraft Records Inc.*, 131 F. (2d) 929 (C. C. A. 2nd), cert. den. 319 U. S. 742; *Marx* v. *United States*, 96 F. (2d) 204 (C. C. A. 9th). As used in Section 1(e), the word "published" would become meaningless if it were construed to refer to an act that could take place many times during the life of a copyrighted work.

Petitioner relies on other sections of the Act in which the word "published" is used. The Court below was clearly correct, however, in concluding that "a reading of the Act in its entirety reinforces the conclusion" which it reached. As that Court pointed out, the use of the two words "published" and "republished" in Section 7 indicates that Congress drew a distinction between the two words, and it would have used both of them in Section 1(e)

if the meaning claimed by petitioner had been intended. In relying on Section 7, petitioner overlooks the significant fact that the protection which that section confers after "republication" relates only to "new matter" that has been added to the original work. Petitioner here seeks mechanical protection for the original work itself, and not for any newly copyrighted material. Nor is it significant that the term "date of publication" defined in Section 62 of the Act (now 17 U. S. C. §26) is not used in Section 1(e). That definition itself illustrates the normal meaning of the word "publication". As applied to works of which copies are produced for sale, the term describes the act by which copies are first publicly distributed. The present composition is such a work, and the publication thereof took place in 1902.

Petitioner's construction of the statute requires a distortion of clear language. No issue calling for a determination by this Court is created by the claim that the statute should be so distorted.

C.

The legislative history of Section 1(e) plainly shows the Congressional purpose to avoid the retroactive application claimed by petitioner.

The legislative history of the Act of 1909 shows that the plain language of Section 1(e) carries out the purpose of the Congress to limit mechanical protection to newly created compositions. This Court, when it upheld the assignability of a renewal copyright, reviewed the "elaborate legislative consideration of the problem of copyright" that led to the enactment of the Copyright Act of 1909. *Fred Fisher Music Co.* v. *Witmark & Sons*, 318 U. S. 643,

652. The House Committee which reported the measure stated that control over mechanical reproduction was "the subject of more discussion" and took "more of the time of the Committee than any other provision in the bill" (H. Rep. No. 2222, 60th Cong., 2nd Sess.)*. The conflict between composers and record manufacturers was resolved by Section 1(e), which granted mechanical control as to newly copyrighted and published works, but subject to the compulsory licensing provision.

During the course of the "elaborate legislative consideration" of the Act of 1909, interested parties as well as members of the Congress plainly expressed the understanding that existing compositions were not to be given mechanical protection. John Philip Sousa, supporting the bill, described the non-retroactive feature as a "sop" to the talking machine companies and said that "hereafter they will mak money after this law passes on the pieces that I made before the law went into effect."** Nathan Burkan, in a brief filed with the committees, said of the section that later became Section 1(e): "The section deals expressly with the works to be written by the composer of the future."*** During one argument in support of the bill, Mr. Burkan said****:

> "The proposed bill is not retroactive. It is to affect only such compositions as are copyrighted

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* Reproduced in Howell, *The Copyright Law* (3rd Ed., 1952), at p. 257.

** Arguments before the Committee on Patents conjointly with the Senate Committee on Patents, on H. R. 19853, June, 1906, p. 24.

*** Copyright hearings, December 7-11, 1906: Arguments before the Committees on Patents of the Senate and House of Representatives, conjointly on S. 6360 and H. R. 19853, p. 222.

**** Hearings before the Committees on Patents of the Senate and House of Representatives on Pending Bills to Amend and Consolidate the Acts Respecting Copyright, March 1908, p. 230.

> from the date of the enactment of the law. All compositions *written* from time immemorial up to the date of the passing of the law are free to the manufacturers of perforated rolls and phonograph records to exploit and make money out of, to their hearts' content, without any interference whatever on the part of any publisher or composer." (Emphasis added.)

Other statements to the same effect appear in the course of the hearings.*

The history of the statute shows further that the word "published" was included in Section 1(e) to assure its prospective application, and that its requirement is not met by subsequent "republication". The 1909 Act introduced a significant change in the procedure by which copyright is secured. Under the prior law it was necessary to file the title and two copies of the work with the Librarian of Congress "on or before the date of publication", Rev. Stat. Sec. 4965, as amended by Act of March 3, 1891. Under Section 9 of the Act of 1909, a work is copyrighted "by publication thereof with the notice of copyright required by this Act". *Washingtonian Publishing Company* v. *Pearson*, 306 U. S. 30. At no time has a new publication or a new copyright notice been required in order to effect the renewal and extension of a copyright. The word "published" in Section 1(e) describes the new procedure for securing copyright adopted in the 1909 Act. It was included in the section for the specific purpose of avoiding retroactive protection to the large body of musical works published

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* Arguments before the Committee on Patents conjointly with the Senate Committee on Patents on H. R. 19853, June, 1906, p. 26; *id.*, pp. 95-6; Copyright Hearings, December 7-11, 1906: Arguments before the Committees on Patents of the Senate and House of Representatives, conjointly on S. 6360 and H. R. 19853, p. 292.

and copyrighted prior to July 1, 1909. This was expressly held in *Shilkret* v. *Musicraft Records, Inc.*, 131 F. (2d) 929, 931 (C. C. A. 2nd), cert. den. 319 U. S. 742.

D.

Subsequent legislative proposals evidence the clear understanding of the Congress and of interested parties that mechanical protection does not extend to pre-1909 works.

The history of legislative proposals to amend the Act of 1909 has brought forth not only clear recognition by members of Congress that renewed pre-1909 copyrights have no protection against mechanical reproduction, but also explicit statements to that effect by those vitally interested on both sides of the issue.

In 1925, hearings were held on a bill (H. R. 11258, 68th Cong., 2nd Sess.) which would have eliminated from Section 1(e) both the proviso making it inapplicable to pre-1909 works and the compulsory licensing provision. Representatives of both the music publishers and the record industry, appearing at those hearings, clearly expressed their understanding that all pre-1909 works were in the public domain, as far as mechanical rights were concerned.* Indeed, the publishers' representative, E. C. Mills, urging enactment of the bill, complained that "although copyright had been granted prior to the passage of the act of 1909 for a term of 28 years, and *renewal* for a like period, as far as mechanical privileges were concerned, the copyright was revoked . . ."**

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* Hearings before Committee on Patents, House of Representatives, 68th Cong., 2nd Sess., on H. R. 11258, pp. 121-2, 275.

** *Ibid*, p. 121.

Measures which would have had the same effect were the subjects of hearings before the House Committee on Patents in 1926* and again in 1928.** Both proposals were supported by Mr. Mills and Mr. Burkan.

On March 4, 1930, Mr. Burkan appeared before the House Committee in support of a more limited bill that would have eliminated the compulsory licensing provision, but not retroactively. In a statement which he made on behalf of ASCAP, he referred to "noted composers whose works lived and breathed long after their creators were gone, but whose widows and orphans get no penny for their reproduction."*** Since it is the widows and orphans who have the right to extend and renew the copyrights in works of deceased authors, it is plain that Mr. Burkan, like Mr. Mills, was concerned about the lack of mechanical protection for works which were the subject of renewed copyrights.

E.

No substantial question is created by petitioner's effort to avoid the clear language of the statute and defeat its obvious purpose by reliance on the concept of copyright renewal as the creation of a "new right".

In its attempt to create a substantial question where none exists, petitioner invokes the concept of a renewed copyright as "in reality an entirely new property right" (petition, p. 12). The issue which petitioner thus attempts to inject into the case would not be determinative. It goes only to the question whether the composition in suit was

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* Hearings before Committee on Patents, House of Representatives, on H. R. 10434, 69 Cong., 1st Sess., April 1926.

** Hearings before Committee on Patents, House of Representatives, on H. R. 10655, 70th Cong., 1st Sess., April 1928.

*** Hearings before Committee on Patents, House of Representatives, 71st Cong., 2nd Sess., on H. R. 9639, p. 22.

"copyrighted" when the copyright was renewed and extended in 1930. In order to have mechanical protection, however, the composition must have been both "published" and "copyrighted" after July 1, 1909. The strained construction of the words "renewed and extended" that would result from application of the concept which petitioner invokes would not, even under petitioner's theory, convert the composition that was published in 1902 into one that was "published" after July 1, 1909 within the meaning of Section 1(e).

Moreover, the words "renewed and extended" will not bear the meaning which petitioner seeks to give them. This can be shown conclusively by (1) a review of the prior legislation relating to copyright renewal; and (2) analysis of the cases cited by petitioner in support of its concept as to the nature of copyright renewal.

(1) Prior legislation relating to copyright renewal.

We set forth in the appendix hereto the text of the renewal sections in all the acts prior to that of 1909, commencing with that of 1790. Those statutes contained varying provisions relating to the length of the original and renewal term and the persons who might secure renewal. The one constant pattern that remained unchanged was the use of language clearly describing the right of renewal as a right to continue and extend an existing grant.

The first Copyright Act, adopted in 1790 (1 Stat. 124), after granting the author certain exclusive rights for a term of fourteen years, provided that "if, at the expiration of the said term, the author or authors * * * be living, * * * the same exclusive right shall be continued to him or them * * * for the further term of fourteen years".

The Act of February 3, 1831 (4 Stat. 436) contained the same language regarding continuance of the original

right. Section 2 introduced for the first time the term "renewed copyright", and did so in a manner that shows plainly that the word "renewed" was used synonymously with "continued". This appears in a proviso requiring that, within six months before the expiration of the first term, the title of the work "shall be a second time recorded, and all such other regulations as are herein required in regard to original copyrights, be complied with in respect to *such renewed copyright.*"

The use of the word "renew" appears in Section 16 of the 1831 Act, with respect to previously obtained copyrights, and in a manner that plainly makes it synonymous with "be continued", as used in Section 2 of that Act. Section 16 provided that if the author was living at the time of the passage of the Act, he "shall continue to have the same exclusive right * * * for such additional period of time as will, together with the time which shall have elapsed from the first entry of such copyright, make up the term of twenty-eight years, with the same right * * * to renew the copyright at the expiration thereof, as is provided in relation to copyrights originally secured under this Act" [i. e., the provision of Section 2 that the right "shall be continued"].

The Act of 1870 (16 Stat. 212), like its two predecessors, provided (Section 88) that the author "shall have the same exclusive right continued for the further term of fourteen years". Again, these words were followed by the term "said renewal". The same language appears in Section 4954 of the Revised Statutes of 1873; it was retained when that Section was amended in another respect by the Act of March 3, 1891 (22 Stat. 181).

The 1909 Act introduced no change in the language used to describe the right of renewal. Section 24, relating to copyrights existing when the Act took effect, is quoted

above. Section 23, quoted in the petition (Appendix III, p. 33) provided for the "renewal and extension" of a copyright secured under that Act "for the further term of twenty-eight years".

The draftsmen of the Act of 1909 were certainly familiar with the past course of legislation on the extension of the copyright term that has been reviewed. In the two renewal sections of the measure which they prepared, they explicitly adhered to the concept of renewal as a continuance or extension of the original term. When they referred, in Section 1(e), to compositions "published and copyrighted" after the effective date of the Act, they plainly intended to exclude all previously published and copyrighted works for the entire term—both original and extended—of their copyrights.

(2) The cases on which petitioner relies.

Petitioner's claim that the scope of the 1902 copyright was enlarged when that copyright was renewed and extended in 1930 rests, as has been stated, upon the concept of renewal as a "new property right". Petitioner itself concedes that its reading of the statute gives it a meaning diametrically opposed to that which it would "express to the ordinary reader" (petition, p. 12). The Court below was plainly right in stating that the concept invoked by petitioner was lifted from cases concerning other problems having no relation to the issue here involved. Those cases are fully consistent with the decision below, and the single decision of this Court relied on by petitioner supports the correctness of the decision below.

The petition (p. 12) contains two quotations purportedly taken from this Court's opinion in *Fox Film Corporation* v. *Knowles,* 261 U. S. 326. The first passage

quoted, however, and the only one in which reference is made to renewal copyright as a "new property right", is not from this Court's opinion but from the argument of the unsuccessful respondent. 261 U. S. at 327. It is in the argument of counsel, and not in this Court's opinion, that the next two cases relied on by the petitioner (*White-Smith Music Pub. Co.* v. *Goff*, 187 Fed. 247 and *Silverman* v. *Sunrise Pictures Corporation*, 273 Fed. 909) are "cited with approval". This Court's opinion refers to the *Goff* case merely in its statement of the argument which the Court rejected. 261 U. S. at 329. It mentions the *Silverman* case only as the authority on which the Court below had relied for the decision which this Court reversed.*

The concept of a renewed copyright as a "new property right" is derived from the fact that the statute designates the individuals who may have the copyright term extended. That concept has never been applied to effect a change in the scope of the original copyright. In the *Knowles* case the Circuit Court of Appeals had invoked that concept in holding that the provision authorizing renewal by an executor applies only when the author dies during the last year of the original term, *i. e.*, when he has the power to renew at the time of his death. In reversing the *Knowles* decision, this Court found in Section 24 "a general intent to secure the continuance of the copyright after the author's death and none the less so if the actual continuance was effected by creating a new estate, or if the beneficiaries in certain cases are pointed out", 261 U. S. at 329.

The concept that a copyright renewal is a new and different property right merely because there may be a "new

* In a later appeal in the *Silverman* case, the Circuit Court of Appeals recognized that this Court had rejected the decision on which petitioner here relies. See *Silverman* v. *Sunrise Pictures Corporation*, 290 Fed. 804, 805 (C. C. A. 2nd).

estate", *i. e.*, ownership by someone other than the owner of the original copyright, was thus squarely rejected by this Court. The reasoning in the *Knowles* opinion, giving effect to the clear intent of the statute to secure the continuance of the original copyright, fully sustains the view taken in the Courts below.

The other cases on which petitioner relies are cases involving issues of ownership and contract, not of the scope of the renewed copyright. In *White-Smith Publishing Co.* v. *Goff*, 187 Fed. 247 (C. C. A. 1st), the holding was that the "proprietor" of a work by assignment to whom copyright may originally be granted had no right to obtain renewal. In *G. Ricordi & Co.* v. *Paramount Pictures, Inc.*, 189 F. (2d) 469 (C. A. 2nd), it was held that rights assigned under a copyright, without any reference to renewal, expired with the original term. The Court below correctly concluded that these cases are not relevant to the present issue.

The sole issue here is whether the composition in suit was "published and copyrighted" after July 1, 1909. It was both published and copyrighted prior to, and not after, that date. The claim that the composition is entitled to mechanical protection under Section 1(e) is wholly unsubstantial. It raises no issue that should be reviewed by this Court.

The petition should be denied.

Respectfully submitted,

Maxwell Okun,
Attorney for Respondents.

APPENDIX.

1. Act of May 31, 1790 (1 Stat. 124):

"SECTION 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled,* That from and after the passing of this act, the author and authors of any map, chart, book or books already printed within these United States, being a citizen or citizens thereof, or resident within the same, his or their executors, administrators or assigns, who hath or have not transferred to any other person the copyright of such map, chart, book or books, share or shares thereof; and any other person or persons, being a citizen or citizens of these United States, or residents therein, his or their executors, administrators or assigns, who hath or have purchased or legally acquired the copyright of any such map, chart, book or books, in order to print, reprint, publish or vend the same, shall have the sole right and liberty of printing, reprinting, publishing and vending such map, chart, book or books, for the term of fourteen years from the recording the title thereof in the clerk's office, as is herein after directed: And that the author and authors of any map, chart, book or books already made and composed, and not printed or published, or that shall hereafter be made and composed, being a citizen or citizens of these United States, or resident therein, and his or their executors, administrators or assigns, shall have the sole right and liberty of printing, reprinting, publishing and vending such map, chart, book or books, for the like term of fourteen years from the time of recording the title thereof in the clerk's office as aforesaid. And if, at the expiration of the said term, the author or authors, or any of them, be living, and a citizenn or citizens of these United States, or resident therein, the same exclusive right shall be continued to him or them, his or their executors, administrators or assigns, for the further

term of fourteen years: *Provided,* He or they shall cause the title thereof to be a second time recorded and published in the same manner as is herein after directed, and that within six months before the expiration of the first term of fourteen years aforesaid."

2. Act of February 3, 1831 (4 Stat. 436):

"That from and after the passing of this act, any person or persons, being a citizen or citizens of the United States, or resident therein, who shall be the author or authors of any book or books, map, chart, or musical composition, which may be now made or composed, and not printed and published, or shall hereafter be made or composed, or who shall invent, design, etch, engrave, work, or cause to be engraved, etched, or worked from his own design, any print or engraving, and the executors, administrators, or legal assigns of such person or persons, shall have the sole right and liberty of printing, reprinting, publishing, and vending such book or books, map, chart, musical composition, print, cut, or engraving, in whole or in part, for the term of twenty-eight years from the time of recording the title thereof, in the manner hereinafter directed.

"SEC. 2. * * * That if, at the expiration of the aforesaid term of years, such author, inventor, designer, engraver, or any of them, where the work had been originally composed and made by more than one person, be still living, and a citizen or citizens of the United States, or resident therein, or being dead, shall have left a widow, or child, or children, either or all then living, the same exclusive right shall be continued to such author, designer, or engraver, or, if dead, then to such widow and child, or children, for the further term of fourteen years: *Provided,* That the title of the work so secured shall be a second time recorded, and all such other regulations as are herein required in regard to original copyrights, be complied with in respect to such renewed copyright, and that within six months before the expiration of the first term.

"SEC. 3. * * * That in all cases of renewal of copyright under this act, such author or proprietor shall, within two months from the date of said renewal, cause a copy of the record thereof to be published in one or more of the newspapers printed in the United States, for the space of four weeks.

* * * * * *

"SEC. 16. * * * That, whenever a copyright has been heretofore obtained by an author or authors, inventor, designer, or engraver, of any book, map, chart, print, cut or engraving, or by a proprietor of the same: if such author or authors, or either of them, such inventor, designer, or engraver, be living at the passage of this act, then such author or authors, or the survivor of them, such inventor, engraver, or designer, shall continue to have the same exclusive right to his book, chart, map, print, cut, or engraving, with the benefit of each and all the provisions of this act, for the security thereof, for such additional period of time as will, together with the time which shall have elapsed from the first entry of such copyright, make up the term of twenty-eight years, with the same right to his widow, child, or children, to renew the copyright, at the expiration thereof, as is above provided in relation to copyrights originally secured under this act. And if such author or authors, inventor, designer, or engraver, shall not be living at the passage of this act, then, his or their heirs, executors and administrators, shall be entitled to the like exclusive enjoyment of said copyright, with the benefit of each and all the provisions of this act for the security thereof, for the period of twenty-eight years from the first entry of said copyright, with the like privilege of renewal to the widow, child, or children, of author or authors, designer, inventor, or engraver, as is provided in relation to copyrights originally secured under this act: *Provided,* That this act shall not extend to any copyright heretofore secured, the term of which has already expired."

3. Act of July 8, 1870 (16 Stat. 212):

"SEC. 87. * * * That copyrights shall be granted for the term of twenty-eight years from the time of recording the title thereof, in the manner hereinafter directed.

"SEC. 88. * * * That the author, inventor, or designer, if he be still living, and a citizen of the United States or resident therein, or his widow or children, if he be dead, shall have the same exclusive right continued for the further term of fourteen years, upon recording the title of the work or description of the article so secured a second time, and complying with all other regulations in regard to original copyrights, within six months before the expiration of the first term. And such person shall, within two months from the date of said renewal, cause a copy of the record thereof to be published in one or more newspapers, printed in the United States, for the space of four weeks."

4. Revised Statutes, 1873, Sections 4953 and 4954, re-enacted Sections 87 and 88 of the Act of July 8, 1870.

5. Act of March 3, 1891 (26 Stat. 1106):

"SEC. 2. That section forty-nine hundred and fifty-four of the Revised Statutes be, and the same is hereby, amended so as to read as follows:

'SEC. 4954. The author, inventor, or designer, if he be still living, or his widow or children, if he be dead, shall have the same exclusive right continued for the further term of fourteen years, upon recording the title of the work or description of the article so secured a second time, and complying with all other regulations in regard to original copyrights, within six months before the expiration of the first term; and such persons shall, within two months from the date of said renewal, cause a copy of the record thereof to be published in one or more newspapers printed in the United States for the space of four weeks.'"

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1955

No. 211

EDWARD B. MARKS MUSIC CORPORATION,

Petitioner,

against

CONTINENTAL RECORD COMPANY, INC. and REMINGTON RECORDS, INC.,

Respondents.

PETITIONER'S REPLY BRIEF

FULTON BRYLAWSKI,
Attorney for Petitioner.

FULTON BRYLAWSKI,
JULIAN T. ABELES,
Of Counsel.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1955

No. 211

EDWARD B. MARKS MUSIC CORPORATION,

Petitioner,

against

CONTINENTAL RECORD COMPANY, INC. and REMINGTON RECORDS, INC.,

Respondents.

PETITIONER'S REPLY BRIEF

1. The text of former Section 24 of the Copyright Act, set forth in respondents' brief (pp. 2, 3), is for every intent and purpose the same as the present Section 24 (former Section 23). While the former Section 24 provides that the original copyright may be *"renewed and extended"** by the persons enumerated, the present Section 24 provides to the same effect that the persons enumerated *"shall be entitled to a renewal and extension"* of the original copyright. In every authority cited in the petition (pp. 12, 13), holding that a renewal is a new grant of copyright, the court had under consideration former Section 24 and made no distinction in the wording or purport of said Section and the present Section 24. In no reported authority has any such distinction been made.

* Italics supplied throughout.

2. The respondents say (p. 6) the fact that the present question has not been previously litigated and determined "shows that it is not now an issue that need be decided by this court". This is answered by the following excerpts from the affidavit of Julian T. Abeles of counsel for petitioner, verified April 25, 1955 (Clerk's Certified Record), submitted by petitioner in opposition to the application by respondent in the court below for the allowance of an attorney's fee, which was denied (Appendix 1 of Petition):

> "This Court said in its opinion in affirming the order granting defendants' motion for summary judgment and dismissing the complaint:
>
> 'None of the many briefs filed in this action have disclosed a precedent which squarely controls the problem here presented.'
>
> The plaintiff in instituting this action relied upon the prior determination of the District Court in *Southern Music Publishing Co., Inc.* v. *Bibo-Lang, Inc.*, 10 F. Supp. 975 (D. C., S. D. N. Y.) and *Jerome* v. *Twentieth Century-Fox Film Corp.*, 67 F. Supp. 736 (D. C., S. D. N. Y.), aff'd 165 F. 2d 784 (in which action I appeared as counsel for defendant). These decisions had theretofore been recognized in the trade as authority for plaintiff's position in the instant case, and the first mentioned case was cited as authority therefor in the leading text book of *Amdur, Copyright Law and Practice* (p. 555). Plaintiff likewise relied upon the line of decisions of this Court to the effect that a renewal copyright is a distinct copyright grant creating a new estate entirely separate and apart from the original copyright.
>
> "In reliance upon the aforementioned authorities plaintiff had instituted a prior action in the court below against Capitol Records, Inc. (No. 70-70) involving the identical claim, as asserted in this action,

for the unauthorized mechanical reproduction of the same song *"In The Good Old Summer Time"*. During the pendency of the said action the defendant therein entered into a stipulation with plaintiff, whereby in consideration of the discontinuance thereof said defendant agreed to pay plaintiff license fees at standard rates for all records of the said song and of eight other songs of plaintiff, manufactured and sold by it.

"In the course of my firm acting as counsel for one Harry Fox, the agent and trustee for over three hundred of the leading music publishers in the United States in the licensing of the right of mechanical reproduction of the musical works of such publishers and in the enforcement of payment for such licensed and unlicensed uses, prior to the institution of this action it had become known to me that all of the reputable mechanical companies had been paying license fees for the mechanical reproduction of musical works of such publishers originally published and copyrighted prior to July 1, 1909. In fact, apart from this action and the aforementioned action against Capitol Records, Inc. no music publisher in the United States had been obliged to institute suit to recover such license fees, with the exception of an action instituted in the District Court by *Broadway Music Corp.* against *Loew's Incorporated* (M. G. M. Records Div.). However even in that action the defendant relied upon the express authorization of the plaintiff to make the mechanical reproduction."

In view of this adverse determination to the music publishers and writers, all of the mechanical companies, which theretofore recognized an obligation for the payment of license fees in respect to the mechanical reproduction of musical works originally published and copy-

righted prior to July 1, 1909, have now refused to pay such license fees even under existing licenses. The respondents say (p. 6) that the issue will become academic after July 1, 1965. However, from the time of the rendition of the District Court's adverse opinion on March 9, 1954 until July 1, 1965, innumerable of the most famous and lasting songs will be in their renewal copyright term, the mechanical reproduction rights of which during that period of eleven years will be invaluable.

3. Respondents say (p. 9) "The word 'published' in its common usage refers to the initial distribution of copies by which common law copyright is lost", citing without quotation *Holmes* v. *Hurst*, 174 U. S. 82, 88; *American Tobacco Company* v. *Werckmeister*, 207 U. S. 284, 299; *Patterson* v. *Century Productions*, 93 F. 2d 489, 492. None of the cited authorities sustain respondents' position. On the contrary the *Holmes* case completely refutes respondents' argument that there cannot be a republication of a copyrighted work (p. 88):

> "That there was a publication of the contents of the book in question, and of the entire contents, is beyond dispute. It follows from this that defendant might have *republished* in another magazine these same numbers as they originally appeared in the Atlantic Monthly."

Likewise, the *Patterson* case completely refutes respondents' argument that the "date of publication", as defined in Section 26 of the Act (former Sec. 62), is a general definition of the word "publication" as used in the Act (p. 492):

> "In deciding this question it becomes necessary to notice section 62 (17 U. S. C. A. Sec. 62). It is there provided that 'in the interpretation and construction of this Act (title) "the date of publication"

> shall in the case of a work of which copies are reproduced for sale, or distribution be held to be the earliest date when copies of the first authorized edition were placed on sale, sold, or publicly distributed.' This, however, as Judge Augustus N. Hand said in Cardinal Film Corp. v. Beck, et al., supra, *'was an enactment to fix the date from which the copyright term should begin to run, and not a general definition of what constituted publication.'* "

In the *American Tobacco* case the question before this Court was, under what circumstances the public exhibition of a painting or statue would amount to a publication, which has no possible bearing upon the point.

The respondents contend (p. 9) without quotation, that *Shilkret* v. *Musicraft Records, Inc.,* 131 F. 2d 929, cer. den. 319 U. S. 742 and *Marx* v. *United States,* 96 F. 2d 204, do not support petitioner's argument as to the elasticity of the word "publication". The pertinent quotations in the petition from both cases (p. 17) completely dissipate respondents' contention.

4. The respondents contend (pp. 15-17) that since the first Copyright Act of 1790 (1 Stat. 124) there has been no change in wording indicating any new policy affecting the grant of a renewal right. On the contrary in *White-Smith Music Pub. Co.* v. *Goff,* 187 Fed. 247 (1st Cir.), the court pointed out (p. 250) that while prior to the 1831 Act (4 Stat. 436) "it was properly assumed that the further term of 14 years was strictly an extension or continuance of the original right, and flowed out of the same in accordance with the ordinary rules of law controlling the devolution of property" in respect to the 1831 Act:

> "It broke up the continuity of title, and gave the right of renewal to the widow or child or children. This clearly recognized the fact that, unlike the view

> entertained early in England, a copyright is purely a matter of statutory grant, as has been settled ever since Wheaton v. Peters, 8 Pet. 591, 8 L. Ed. 1055, decided in 1834, and recognized by at least several statutes by which Congress has arbitrarily granted copyrights to persons who had not entitled themselves thereto under any existing law. Here, then, was an entirely new policy, completely dissevering the title, *breaking up the continuance in a proper sense of the word,* whatever terms might be used, and *vesting an absolutely new title eo nomine in the persons designated.*
>
> • • • •
>
> "Whatever might occur afterwards would be *entirely a new grant,* and, whatever the language used in section 2 of the act of 1831, such was the condition, and *whatever further rights arose were disconnected from the original right.*"

The court likewise pointed out that in every subsequent act this radical change of policy has been persisted in (p. 251):

> "In every act since that of 1831, this method of vesting the right to an extension eo nomine has been persisted in. The purpose of these provisions is singularly illustrated by the fact that all the author's administrators are shut out; but his executors, whom he may appoint at his will, are let in. This continues in sections 23 and 24 of the present act of 1909."

5. In the quotation from *Fox Film Corp.* v. *Knowles,* 261 U. S. 326 (Petition, p. 12) during the author's absence from the office the typist inadvertently typed the first passage from the argument of counsel in that case, which passage and all references thereto should be disregarded. This unfortunately occurred because of a pencil mark

opposite the quoted part, to call attention to the fact that the cited cases should be examined. This was likewise unexplainedly overlooked when the quotation was checked back by two of the personnel of the office. Respondents say with reference to this case (p. 18) "In reversing the *Knowles* decision, this court found in Section 24 'a general intent to secure the continuance of the copyright after the author's death and nonetheless so if the actual continuance was effected by creating a new estate, or if the beneficiaries in certain cases are pointed out', 261 U. S. at 329". Respondents then say that this Court thereby "squarely rejected" the concept that a copyright renewal is a new and different property right. However, reference to the decision discloses that the following wording preceding the above quotation has been omitted (p. 329):

> "The section read as a whole *would express to the ordinary reader*"

The quotation in its entirety thus dissipates the respondents' contention.

6. The following is the material part of a quotation in the petition (p. 13) from *Silverman* v. *Sunrise Pictures Corporation*, 273 Fed. 909, 911, "the statute does not really give to the author a true extension or renewal, but authorizes 'a new grant to the author, or the others enumerated' in Section 24". The respondents say in reference to this quotation (p. 18, footnote) that upon a later appeal in the *Silverman* case (*Silverman* v. *Sunrise Pictures Corporation*, 290 Fed. 804, 805 (2d Cir.)), the Circuit Court of Appeals recognized that this Court had rejected its said determination on which petitioner relies. On the contrary, the Circuit Court distinctly said upon such appeal (cer. den. 262 U. S. 758) that in the judgment of the court the only holding of this Court in the *Fox Film* case concerned the question whether under Section 24, an executor in

the absence of a widow, widower or child should have the same right of renewal as his testator might have exercised had he continued to survive, viz. (p. 805):

> "We had erroneously construed the statute 'as vesting the right [of applying for renewal copyright] in or imposing the duty on executors, only when the power or privilege of obtaining renewal was existing in the testator author at the moment of decease.' 273 Fed. 913. We are now informed that *the executor, on the contrary, is by the statute 'given rights that the testator could not have exercised while he lived.'* That construction and holding was sufficient to dispose of the Fox Film case, *and nothing more than that can in our judgment be extracted from the ruling opinion.*"

Likewise, in the instant case the Court below said (Petition, Appendix 1) that none of the briefs "disclosed a precedent which squarely controls the problem here presented", and that this action involves "a novel question of statutory interpretation."

Accordingly, this Court has never determined the point in issue.

The petition for a writ of certiorari should be granted.

Respectfully submitted,

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